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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/116,019 09/02/93 BEERY

26M1/0304

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J JB2.3
EXAMINER

COHEN, C

ART UNIT PAPER NUMBER

2602

DATE MAILED:

03/04/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 1-11-95 1-19-95 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. <u>2/22/94; 8/14/94; 1/11/95</u> | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-56 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☒ Claims 1-5 are allowed.
4. ☒ Claims 6-56 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other _____

EXAMINER'S ACTION:

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1. While there is concurrent litigation related to this reissue application, action in this reissue application will NOT be stayed because of applicant's request that the application be examined at this time. Due to the related litigation status of this reissue application, extensions of time under the provisions of 37 C.F.R. § 1.136(a) will not be permitted.

2. The reissue oath or declaration filed with this application is defective because Applicant has failed to point out how errors arose in the Reexamination of Patent No. 5,068,734. Applicant has only alleged errors as they arose in the prosecution of Patent No. 5,045,947. However, by including the Reexamination of Patent No. 5,068,734 as the basis for this reissue application Applicant is admitting that an error arose in the prosecution of the Reexamination of Patent No. 5,068,734 by attempting to broaden the coverage of the Reexamination of Patent No. 5,068,734 in this reissue of Patent No. 5,045,947.

3. Claims 6-56 are rejected as being based upon a defective reissue declaration under 35 U.S.C. § 251. See 37 C.F.R. § 1.175. Applicant has failed to point out very specifically what the defects are and for each error state how and when the error arose, and how and when each error was discovered.

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4. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as the specification, as originally filed, does not provide support for the invention as is now claimed.

As originally filed, the specification fails to provide support for the term "solely" as set forth in independent claims 6, 20 & 29. The term "solely" is a negative limitation which restricts the claimed invention. Insertion of the term "solely" introduces new matter into the claims which is not properly supported by the specification as originally filed.

5. Claims 6, 20 & 29 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

It is brought to Applicant's attention that if in response to the rejection under 35 U.S.C. section 112, first and second paragraph rejections set forth above, applicant deletes the term "solely" from the claims then the Examiner will consider the

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patentability of the claims in view of Belisomi (U.S. Patent No. 4,600,918).

6. The following minor distinctions have been identified in the claims from those claims which applicant has identified in the declaration that they correspond. Applicant is requested to review such changes to determine if they were inadvertent.

Claim 7, line 24 & claim 30, line 24, "each" has been substituted for "at least one".

Claim 16, lines 8, 13, 20 & 24, "marker" has been substituted for "marker/order".

Claim 32, line 17, "after" has been substituted for "upon".

7. Claims 16-31, 33-37, 42, 43, 50, 55 & 56 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16 & 28, lines 28, 29, 33, 34 & 36; claim 37, lines 28, 29, 32, 33 & 34; and, claims 42 & 43, lines 29, 30, 34, 35, & 37: "said channel select designations" lacks proper antecedent basis and should be rewritten as "said marker bit associated with one of said channel tuning designations".

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Claim 17, line 21; claim 30, line 21; and, claim 50, line 18: "said processor signal" lacks proper antecedent basis and should be rewritten as "said channel tuning control signal".

Claim 33, line 33, "said memory means" lacks proper antecedent basis and should be rewritten as "said memory".

Claim 55, line 3, "said second control signal" lacks proper antecedent basis. Therefore, Applicant should amend claim 5, line 13 and insert after "second" the following phrase "control output signal comprising a second".

As for claim 56 it is unclear what the difference is between the terms "first control output signal" and "desired channel select designation" since both refer to the same thing.

Claims 17-31 & 33-37 are rejected because the phrase "in response to" is indefinite. It is unclear the distinction between the phrases "upon receipt of" and "in response to".

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 13 & 26 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,600,918 (hereinafter "Belisomi").

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Belisomi discloses (Figure 1) a control unit capable of controlling a television receiver to a television channel corresponding to a preassigned tuning designation reading on all the limitations as set forth in claims 13 & 26 including: a RAM (7) comprising a first group of cells and a second group of cells; a remote control transmitter comprising an alphanumeric keyboard (representing a single operator-actuated control means) for generating signals to create labels corresponding to tuning designations and then selecting a particular label; and, a microcomputer (3) for receiving the control signals transmitted from the remote control transmitter (operator-actuated control means) and storing the created labels in the memory and then retrieving the corresponding tuning designation from memory when the operator makes a label selection through the keyboard. The Examiner notes that in interpreting the scope of claims 13 & 26, first and second operator-actuated control means may be construed as being either separate in location in the form of two distinct units or together in a single unit. For the purposes of the art rejection above, the Examiner has met one possible interpretation of the limitation and therefore the claimed invention is anticipated in view of Belisomi which clearly teaches a single keyboard unit.

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9. Claims 1-12, 14-25 and 27-56 are allowable over the prior art of record.

10. Due to the related litigation status of this application, extensions of time under the provisions of 37 C.F.R. § 1.136(a) will not be permitted during the prosecution of this application.

THE TIME PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE ONE MONTH FROM THE DATE OF THIS ACTION. THIS ONE MONTH PERIOD MAY BE EXTENDED ONLY UPON A SHOWING OF CLEAR JUSTIFICATION PURSUANT TO 37 C.F.R. 1.136(b).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Cohen whose telephone number is (703) 308-5080. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 305-4741. The fax phone number for this Group is (703) 305-9509.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.



Cheryl Cohen
February 29, 1996



SAFET METJAHIC
PRIMARY EXAMINER
GROUP 2600